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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,109	09/29/2003	Andrew John Farnsworth	1578.622	2439

  

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RESEARCH IN MOTION		
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EXAMINER
NGUYEN, KHAI MINH

  

ART UNIT	PAPER NUMBER
2617	

  

MAIL DATE	DELIVERY MODE
02/22/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/674,109

Applicant(s)

FARNSWORTH ET AL.

Examiner

Khai M. Nguyen

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The abstract of the disclosure is objected to because of informalities. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vialen et al. (U.S.Pat-6898429) in view of Sharma (U.S.Pub-20050009527 (provisional application No. 60/486584)).

Regarding claim 1, Vialen teaches a method of processing a message in a User Equipment (UE) mobile telecommunications device, the method comprising, in the UE mobile telecommunications device:

receiving a Cell Update Confirm (CUC) message (fig.4-5, section 350. col.7, lines 32-65);

determining whether the UE mobile telecommunications device has an empty cell identifier variable (abstract, if the mobile station is in or is about to enter into such a state (empty cell identifier variable), in which the mobile station needs a c-RNTI, and if that is the case, the c-RNTI is indicated to the mobile station. Preferably, the indication

is effected by attaching the c-RNTI identifier to a message, which causes the change of the mobile station to the state, in which the mobile station needs the c-RNTI identifier);

when the UE mobile telecommunications device has an empty cell identifier variable (abstract), determining whether the CUC message includes a new value for the cell identifier (abstract, if the mobile station is in or is about to enter into such a state (empty cell identifier variable), in which the mobile station needs a c-RNTI, and if that is the case, the c-RNTI is indicated to the mobile station. Preferably, the indication is effected by attaching the c-RNTI identifier to a message, which causes the change of the mobile station to the state, in which the mobile station needs the c-RNTI identifier);

Vialen fails to specifically disclose when the CUC message does not include a new value for the cell identifier and the CUC message would cause the UE mobile telecommunications device to enter a state which requires the UE mobile telecommunications to respond to the message before entering the state, carrying out at least one further step prior to entering the state. However, Sharma teaches when the CUC message does not include a new value (C-RNTI) for the cell identifier (fig.2-4, page 3, lines 1-10) and the CUC message would cause the UE mobile telecommunications device to enter a state which requires the UE mobile telecommunications to respond to the message before entering the state (page 6, line 21 to page 7, line 22), carrying out at least one further step prior to entering the state (page 6, line 21 to page 7, line 22). Therefore, it would been obvious to one having

ordinary skill in the art at the time the invention was made to apply the teaching of Sharma to Vialen to avoid a lot of un-necessary signaling between UE and UTRAN.

Regarding claim 2, Vialen and Sharma further teach a method according to claim 1 wherein the further step comprises:

setting the INVALID\_CONFIGURATION to TRUE (see Sharma, page 4, line 4 to page 5, line 7).

Regarding claim 3, Vialen and Sharma further teach a method according to claim 2 wherein the further step further comprises:

sending a cell update message to the network (see Sharma, page 6, line 21 to page 7, line 22).

Regarding claim 4, Vialen and Sharma further teach a method according to claim 2 wherein the further step further comprises:

returning to an idle state (see Vialen, col.6, line 66 to col.7, line 17).

Regarding claim 5, Vialen and Sharma further teach a method according to claim 1 wherein the further step comprises:

sending a new cell update message including a field that indicates that the cause for the cell update message is cell reselection (see Vialen, fig.4-5, col.7, line 32 to col.8, line 37).

Regarding claim 6, Vialen and Sharma further teach a method according to claim 1 wherein the further step comprises:

acting on the cell update confirm message without transmitting a response to the network (see Vialen, fig.4-5, col.7, line 32 to col.8, line 37).

Regarding claim 7, Vialen and Sharma further teach a method according to claim 1 wherein the further step comprises:

ignoring the cell update confirm message (see Vialen, col.5, line 53 to col.6, line 4).

Regarding claim 8, Vialen and Sharma further teach a method according to claim 1 wherein the cell identifier variable is C\_RNTI and the value of the cell identifier is C-RNTI (see Vialen, col.6, lines 16-41).

Regarding claim 9, Vialen teaches a User Equipment (UE) device including apparatus for processing a message in a mobile telecommunications system, the apparatus being arranged to:

receive a Cell Update Confirm (CUC) message from a network (fig.4-5, section 350. col.7, lines 32-65);

determine whether the UE device has an empty C\_RNTI variable (abstract, if the mobile station is in or is about to enter into such a state (empty cell identifier variable), in which the mobile station needs a c-RNTI, and if that is the case, the c-RNTI is

indicated to the mobile station. Preferably, the indication is effected by attaching the c-RNTI identifier to a message, which causes the change of the mobile station to the state, in which the mobile station needs the c-RNTI identifier);

when the UE device has an empty C\_RNTI variable (abstract), determine whether the CUC message includes a new C-RNTI (abstract);

Vialen fails to specifically disclose when the CUC message does not include a new value for the cell identifier and the CUC message would cause the UE mobile telecommunications device to enter a state which requires the UE mobile telecommunications to respond to the message before entering the state, carrying out at least one further step prior to entering the state. However, Sharma teaches when the CUC message does not include a new value (C-RNTI) for the cell identifier (fig.2-4, page 3, lines 1-10) and the CUC message would cause the UE mobile telecommunications device to enter a state which requires the UE mobile telecommunications to respond to the message before entering the state (page 6, line 21 to page 7, line 22), carrying out at least one further step prior to entering the state (page 6, line 21 to page 7, line 22). Therefore, it would be obvious to one having ordinary skill in the art at the time the invention was made to apply the teaching of Sharma to Vialen to avoid a lot of unnecessary signaling between UE and UTRAN.

Regarding claim 10 is rejected with the same set forth in claim 2.

Regarding claim 11 is rejected with the same set forth in claim 3.



Regarding claim 12 is rejected with the same set forth in claim 4.

Regarding claim 13 is rejected with the same set forth in claim 5.

Regarding claim 14 is rejected with the same set forth in claim 6.

Regarding claim 15 is rejected with the same set forth in claim 7.

Regarding claim 16, Vialen teaches a mobile telecommunication device incorporating apparatus according to any of claims 9 to 15 (see rejection above of claims 9-15).

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khai M. Nguyen whose telephone number is 571.272.7923. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on 571.272.7915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Khai Nguyen  
Au: 2617

2/12/2008